

REMARKS

Claims 1-53 are pending in the present application. Claims 1-17 and 22-53 were previously withdrawn from consideration as drawn to a non-elected invention. By virtue of this response, claims 18-19 have been amended. Support for the amendment to claim 18 can be found in the instant specification at least at paragraph [0015], Figure 1 and in the priority application USSN 60/302,648 at page 2, lines 21-22 and Figure 1. Support for the amendment to claim 19 can be found in the instant specification at least in Figures 1 and 9. Accordingly, claims 18-21 are currently under consideration. Amendment and cancellation of certain claims is not to be construed as a dedication to the public of any of the subject matter of the claims as previously presented. Applicants reserve the right to prosecute any canceled or amended subject matter in related applications. Applicants request rejoinder of methods claims to the extent they incorporate all the limitations of amended composition claims.

Priority

The Examiner has indicated that the specification states priority of this application to US Provisional Application No. 60/302,648 filed July 5, 2001. The Examiner alleges that 60/302,648 expired on August 31, 2003 before the instant application was filed on January 5, 2004, and alleges the instant application does not receive the priority date of July 5, 2001 from 60/302,648. The examiner further noted that 60/302,648 has only Figures 1-6 and lacks Figures 7-9 of the instant application.

Applicants have amended the Reference to Related Applications section to recite that this application is a continuation of PCT/US02/21066 with an international filing date of July 3, 2002, now abandoned, which claims the benefit of priority to U.S. Provisional Application No. 60/302,648, entitled "Coactivators in the Diagnosis and Treatment of Breast Cancer," filed July 5, 2001. Applicants believe that the Examiner's allegation that the priority application "60/302,648 expired on August 31, 2003" appears to be an error. USSN 60/302,648 was filed with Figures 1-6. Application PCT/US02/21066 was filed with Figures 1-9.

Applicants are entitled to the benefit of priority to USSN 60/302,648 filed July 5, 2001 and request that the Examiner clarify this for the record.

Specification

The disclosure is objected to because of the following informalities: the specification comprises a question mark “?”, on many pages where it seems there should be a delta “ Δ ” when referencing Δ 3-AIB1; and because of the heading on page 6 which recites “Description of the Figure”.

Applicants have amended the specification to correct these inadvertent word processing errors thereby obviating this objections.

Claim Objections

A. Claim 19 is objected to because of the following informalities: Claim 19 appears to have a typo. There is a question mark “?” that should be changed to a delta “ Δ ” when referring to Δ 3-AIB1.

Applicants have amended the claim to correct this inadvertent word processing error thereby obviating this rejection.

B. Claim 18 is objected to for containing subject material that is drawn to a non-elected invention. The claim recites “isoform of claim 1” which is a non-elected claim. Amendments to the claims to include all of the limitations of claim 1 and to delete referenced claim 1 would obviate the rejection.

Applicants have amended claim 18 thereby obviating this rejection.

C. Claim 18 is objected to because of the following informalities: Claim 18 appears to have a typo: “An isolated nucleic sequences” should be “An isolated nucleic sequence” in singular form.

Applicants have amended claim 18 thereby obviating this rejection.

In view of the above, Applicants request withdrawal of these objections.

Claim Rejections Under 35 U.S.C. 112, Second Paragraph

Claims 18-21 stand rejected under 35 U.S.C. 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner alleges that the recitation of “AIB1” or “ $\Delta 3$ -AIB1” renders the claims indefinite. Applicants disagree. The designation of the term “AIB1” is an art known designation for a steroid receptor coactivator amplified in breast, a member of the SRC-1 family. For example, see priority application 60/302,648 reference 25 Guan et al., 1996, Cancer Research 56, 3446-3450, incorporated by reference. Therefore, Applicants submit that this term is well known in the art and is clear. While not acquiescing to this rejection and solely in an effort to expedite prosecution, Applicants have amended claim 18 to recite steroid receptor coactivator amplified in breast, thereby obviating this rejection.

Applicants request withdrawal of this rejection of claims.

Claim Rejections Under 35 U.S.C. § 102(b)

A. Claims 18-21 stand rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Reiter et al. (J of Biological Chemistry, 2001. 276:39736-39741, IDS).

Applicants traverse this rejection of claims. As described above, the instant application is entitled to priority to provisional application 60/302,648, filed July 5, 2001. Reiter et al was published in the issue of October 26, 2001 (with a JBC Paper in Press publication of Aug 31, 2001).

Therefore, Reiter et al. is not available under Section 102 for rejection of the instant application. Therefore, Applicants request withdrawal of this rejection of claims.

B. Claims 18, 20, and 21 stand rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Chen et al. (Cell, 1997, 90:569-580).

Applicants traverse this rejection of claims. In order for a reference to anticipate a claim, each and every element of the claimed invention must be found in the reference. Chen et al. does not teach an isolated nucleic acid sequence that encodes a steroid receptor coactivator amplified in breast (AIB1) protein isoform, wherein said isoform contains a deletion of exon 3 in the amino terminus of the AIB1, and therefore, as a matter of law, cannot anticipate the claimed invention. Therefore, Applicants request withdrawal of this rejection of claims.

C. Claims 18 and 21 stand rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Takeshita et al. (J of Biology Chemistry, 1997, 272:27629-27634).

Applicants traverse this rejection of claims. In order for a reference to anticipate a claim, each and every element of the claimed invention must be found in the reference. Takeshita et al. does not teach an isolated nucleic acid sequence that encodes a steroid receptor coactivator amplified in breast (AIB1) protein isoform, wherein said isoform contains a deletion of exon 3 in the amino terminus of the AIB1, and therefore, as a matter of law, cannot anticipate the claimed invention. Therefore, Applicants request withdrawal of this rejection of claims.

D. Claims 18, 20, and 21 stand rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by US Patent 6,562,589, Meltzer et al., issued May 13, 2003, filed August 21, 1998.

Applicants traverse this rejection of claims. In order for a reference to anticipate a claim, each and every element of the claimed invention must be found in the reference. Meltzer et al. do not teach an isolated nucleic acid sequence that encodes a steroid receptor coactivator amplified in breast (AIB1) protein isoform, wherein said isoform contains a deletion of exon 3 in the amino

terminus of the AIB1, and therefore, as a matter of law, cannot anticipate the claimed invention. Therefore, Applicants request withdrawal of this rejection of claims.

CONCLUSION

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

In the event the U.S. Patent and Trademark office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing docket no. 544582000100. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

Dated: December 18, 2006

Respectfully submitted,

By 
Debra J. Glaister

Registration No.: 33,888
MORRISON & FOERSTER LLP
755 Page Mill Road
Palo Alto, California 94304-1018
(650) 813-5725